

Serial No. 10/698,821

PATENT  
Docket No. 54317-024501**REMARKS**

Examination of the present application is to be based on claims 1-9.

The office action of September 1, 2004 and the art relied on by the Examiner have been carefully examined.

**I. Amendments to the claims**

Claims 1-9 are pending in the present application.

Applicant has amended claims 6 for clarity reasons to recite *"the cartoon character is a Disney® cartoon character formed by a first substantially circular element representing a head, a second substantially circular element and a third substantially circular element representing ears, the first element located below and adjacent the second and third elements"*.

Applicant has also amend claim 1 to recite: *"the control panel having ...at least one region encircling a control key, ... said region having an outline shape approximating that of at least a part of a predetermined cartoon character"*.

Similarly, Applicant has amended claim 2 to recite: *"at least one control key arranged on the housing, a region encircling said at least one control key having an outline shape approximating that of at least a part of a predetermined cartoon character"*.

Applicant has also amended claim 4 to recite: *"a control panel arranged on the housing, the control panel having a plurality of control keys and a region encircling a control key, wherein said region has an outline shape approximating that of at least a part of a predetermined cartoon character and an outline shape of the housing approximates that of at least a part of a predetermined cartoon character"*.

Support for the above language can be found, for example, in Figure 6 (see also element 102) and related portions of the specification.

No new matter has been added.

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Docket No. 54317-024501**II. Claim rejections – 35 USC § 112**

In the Action, the Examiner rejects claim 6 under 35 USC § 112, second paragraph because “claim 6 contains the trademark Disney ® ...[and] the claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product.” (Action page 2, lines 9-14).

Applicant has amended claim 6 as shown in the enclosed list of claims and respectfully submits that the rejection of the Examiner has been overcome.

In particular, the Applicant points out that the presence of a trademark in a claim is not *per se* improper (MPEP 2173.05(u)). In this respect, the trademark can be used if it is not intended as a limitation in the claim and it is used to identify a source of goods. (see MPEP 2173.05(u) quoting *Ex parte Simpson*).

In claim 6 as amended, the limitation referred to the cartoon character is given by the combination of the elements forming the cartoon character. Accordingly, the use of the trademark Disney ® in claim 6 is not a limitation and it is intended to clarify the source of the cartoon character identified by the combination of the three elements recited in the claims.

**III. Claim rejections – 35 USC § 102 - Miyai**

In the Action, the Examiner rejects claims 1 to 9 as being anticipated by Miyai (U.S. Des. 321,514). Applicant respectfully disagrees.

1.

a. Independent claim 1 recites “...a predetermined cartoon character ...” (Emphasis added).

Although Miyai shows “a cassette tape player” (see Miyai’s title), the Examiner has not shown to the Applicant where Miyai shows “*a predetermined cartoon character*”, but for a

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generic reference to Figures 1 and 2 of Miyai. The Applicant has looked at those Figures and does not understand where such "*predetermined cartoon character*" is shown.

b. Additionally, independent claim 1 recites "...*a control panel ... having a plurality of control keys ....at least one of the control keys ...having an outline shape approximating that of at least a part of a predetermined cartoon character.*" (Emphasis added)

Although Miyai's "cassette tape player" shows control keys, the Examiner has not shown to the Applicant where Miyai shows "*a control key ....having an outline shape approximating that of at least part of a predetermined cartoon character*" (Emphasis added). The control keys in Miyai appear to be usual, round control keys.

c. Furthermore claim 1, as amended recites: "...*a control panel ... having ...at least one region encircling a control key,... said region having an outline shape approximating that of at least a part of a predetermined cartoon character.*" (Emphasis added)

The Applicant was not able to identify, in Miyai, "...*a region encircling a control key having an outline shape approximating that of at least a part of a predetermined cartoon character.*" In particular, Miyai does not show control keys encircled by regions having the above shape.

d. Therefore, the Applicant submits that claim 1 is novel over Miyai together with claims 5 to 7 at least by virtue of their dependence on claim 1.

Should the Examiner disagree with the Applicant, the Examiner is respectfully requested to show to the Applicant where Miyai teaches or discloses the above features, bearing in mind that a simple reference to the Figures, without citing in detail a more precise portion of the drawings or written passages in Miyai would be unhelpful to the Applicant. (See 37 CFR 1.104 (c)(2) and MPEP 706).

2.

a. Independent claim 2 recites "... *a predetermined cartoon character.*" (Emphasis added).

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The Applicant submits that Miyai does not disclose the above mentioned feature for substantially the same reasons reported on point 1a above.

b. Independent claim 2 additionally recites: "*at least one control key arranged on the housing, a region encircling said at least one control key having an outline shape approximating that of at least a part of a predetermined cartoon character.*" (Emphasis added)

The Applicant submits that Miyai does not disclose the above mentioned feature for substantially the same reasons reported on point 1c above.

c. Therefore, the Applicant submits that claim 2 is novel over Miyai together with claims 5 to 7 at least by virtue of their dependence on claim 2.

3.

a. Independent claim 3 recites: "... predetermined cartoon character."(Emphasis added).

The Applicant submits that Miyai does not disclose the above mentioned feature for substantially the same reasons reported on point 1a above.

b. Independent claim 3 recites: "...*a control means arranged on the housing, the control means being made up of at least one component part which defines an outline shape approximating that of at least a part of a predetermined cartoon character.*"(Emphasis added)"

The Applicant submits that Miyai does not disclose the above mentioned feature for substantially the same reasons reported on point 1b above.

c. Therefore, the Applicant submits that claim 3 is novel over Miyai together with claims 5 to 7 at least by virtue of their dependence on claim 3.

4.

a. Independent claim 4 recites: "... a predetermined cartoon character." (Emphasis added)

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The Applicant submits that Miyai does not disclose the above mentioned feature for substantially the same reasons reported on point 1a above.

b. Independent claim 4 also recites: "*a control panel ... having a plurality of control keys and a region encircling a control key, wherein said region has an outline shape approximating that of at least a part of a predetermined cartoon character...*" (Emphasis added)

The Applicant submits that Miyai does not disclose the above mentioned feature for substantially the same reasons reported on point 1c above.

c. Independent claim 4 additionally recites: "*a control panel arranged on the housing... an outline shape of the housing approximates that of at least a part of a predetermined cartoon character.*" (Emphasis added)

Although Miyai's "a cassette tape player" includes a housing, the Examiner has not shown to the Applicant where in Miyai "... *an outline shape of the housing approximates that of at least a part of a predetermined cartoon character...* " is shown. The outline shape of Miyai's housing is substantially a cube.

d. Therefore, the Applicant submits that claim 4 is novel over Miyai together with claims 5 to 9 at least by virtue of their dependence on claim 4.

#### IV. Claim rejections – 35 USC § 102 - Hood

In the Action, the Examiner also rejects claims 1 to 9 as being anticipated by Hood et al (U.S. Des. 456,049). Applicant respectfully disagrees.

5.

a. Independent claim 1 recites "*...a control panel arranged on the housing, the control panel having a plurality of control keys ....at least one of the control keys ...having an outline shape approximating that of at least a part of a predetermined cartoon character.*" (Emphasis added)

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In Hood (Figure 1), control keys are present on the keyboard, in the mouse, and on the front panel of the screen. The only element in which control keys are arranged on the housing is the screen box.

The Examiner has not shown and the Applicant was not able to see where in Hood "at least one control key" of the control panel on the housing has "an outline shape approximating that of at least a part of a predetermined cartoon character" is shown. In Hood, the control keys on the front panel of the screen appear to have just a circular shape.

b. Furthermore claim 1, as amended, recites: "...a control panel arranged on the housing, the control panel having ...at least one region encircling a control key... said region having an outline shape approximating that of at least a part of a predetermined cartoon character." (Emphasis added)

The Applicant submits that Hood does not show on the housing "a region encircling a control key... said region having an outline shape approximating that of at least a part of a predetermined cartoon character." (Emphasis added).

c. Therefore the Applicant submits that Hood does not disclose or teach the above mentioned features.

Should the Examiner disagree with the Applicant, the Examiner is respectfully requested to show to the Applicant where Hood teaches or discloses the above features, making a detailed reference to the drawings or written passage of Hood (See 37 CFR 1.104 (c)(2) and MPEP 706).

6.

a. Independent claim 2 additionally recites: "at least one control key arranged on the housing, a region encircling said at least one control key having an outline shape approximating that of at least a part of a predetermined cartoon character." (Emphasis added)

The Applicant submits that Hood does not disclose the above mentioned feature for substantially the same reasons reported on point 5b above.

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b. Therefore, the Applicant submits that claim 2 is novel over Hood together with claims 5 to 7 at least by virtue of their dependence on claim 2.

7.

a. Independent claim 3 recites: "...a control means arranged on the housing, the control means being made up of at least one component part which defines an outline shape approximating that of at least a part of a predetermined cartoon character." (Emphasis added)"

The Applicant submits that Hood does not disclose the above mentioned feature for substantially the same reasons reported on point 5a above.

b. Therefore, the Applicant submits that claim 3 is novel over Hood together with claims 5 to 7 at least by virtue of their dependence on claim 3.

8.

a. Independent claim 4 also recites: "a control panel arranged on the housing, the control panel having a plurality of control keys and a region encircling a control key, wherein said region has an outline shape approximating that of at least a part of a predetermined cartoon character..." (Emphasis added)

The Applicant submits that Hood does not disclose the above mentioned feature for substantially the same reasons reported on point 5b above.

b. Therefore, the Applicant submits that claim 4 is novel over Hood together with claims 5 to 9 at least by virtue of their dependence on claim 4.

9.

As a consequence, claim 1 to 4 are also novel over Hood, together with claims 5 to 9 at least by virtue of their dependence on claims 1 to 4.

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Should matters remain which the Examiner believes could be resolved in a further telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred to when charging any payments or credits for this case.

Respectfully submitted,

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